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EXAMINER
CAMPOS, YAIMA

ART UNIT	PAPER NUMBER
2185	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	Applicant(s)
	10/684,001	GOLD ET AL.
Office Action Summary	Examiner	Art Unit	
	YAIMA CAMPOS	2185	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 July 2008*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1, 3-10, 12-19, 21-25* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-10, 12-19, 21-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   **Office Action Summary**   Part of Paper No./Mail Date 20081104

DETAILED ACTION

1.   As per the instant Application having Application number 10/684,001, the examiner

acknowledges the applicant's submission of the amendment dated July 31, 2008. At this point,

claims 17 and 22-25 have been amended and claims 2, 11, 20 and 26 stand canceled. Claims 1,

3-10, 12-19, and 21-25 are pending.

REJECTIONS BASED ON PRIOR ART

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the
statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined
application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46
USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ
645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA
1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to
overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the
conflicting application or patent either is shown to be commonly owned with this application, or claims an invention
made as a result of activities undertaken within the scope of a joint research agreement.
        Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal
disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2.   **Claims 1, 17 and 23** are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claim 12 (dependent from claim

10) of copending Application No. 10/684,207.

3.   Initially, it should be noted that the present application and Application No. 10/684,207,

have the same inventive entity. The assignee for both applications is Hewlett-Packard

Development Company, L.P.

4.   Claimed subject matter in the instant application is fully disclosed in the referenced

copending application and would be covered by any patent granted on that copending application

since the referenced copending application and the instant application are claiming common

subject matter, as noted below. *See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir.*

1993).

5.   Furthermore, there is no apparent reason why applicant would be prevented from

presenting claims corresponding to those of the instant application in the other copending

application. See MPEP § 804.

6.   For example, claim 1 of the instant Application is compared with claim 12, dependent

from claim 10 of Application No. 10/684,207. (The rationale in the comparison to claim 1 show

bellow also applies to claims 17 and 23 of the instant Application.

7.   Claim 1 in the instant Application is anticipated by patent claim 12 of Application

10/684,207 in that claim 12 of Application 10/684,207 contains all the limitations of claim 1 in

the instant application; thus this rejection comprises a non-statutory obviousness type –

anticipation double patenting rejection.

Instant Application	Application 10/684,207
Claim 1	Claims 10
A method comprising:	A method comprising: receiving a list
obtaining information <u>regarding a future</u>	comprising media and at least two backup
<u>backup</u> from one or more backup applications	devices, wherein a first medium in the list is
for a plurality of backup jobs;	assigned to a first backup device, and a second
	medium in the list is assigned to a second
	backup device; ordering the list by physical
	location of the at least two backup devices; and

	presenting at least the media portion of the ordered list to a user, wherein receiving the list of media comprises receiving a list of media from a user to be used for one or more future executions of one or more backup jobs associated with the backup devices, said method further comprising, before receiving the list,
calculating a <u>projected</u> number of media for a <u>future execution</u> of at least one of the backup jobs using the information <u>regarding the future backup</u>, said calculating <u>also</u> comprising dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job	12. (Original) The method of claim 10, wherein calculating the required number of scratch media comprises for at least one of the future executions, dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job.
and presenting the <u>projected</u> number of media to a user.	Claim 10 calculating a required number of scratch media

	needed for the future executions and presenting the required number of scratch media to the user.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

9.   **Claims 1, 3-5, 8-10, 12-19 and 21-25** are rejected under 35 U.S.C. 103(a) as being

unpatentable over Bolin et al. (US 5,664,146) in view of Kanai et al. (US 2002/0152181).

10.   As per **claims 1, 17 and 23**, Bolin discloses a method/system/machine readable medium

having stored thereon sequences of instructions comprising: obtaining information regarding a

future backup from one or more backup applications for a plurality of backup jobs; **[Bolin**

discloses migration and backup of data (col. 7, lines 5-8) wherein all cartridges are used for

storage of data, and are intended to be written to or read in the future (figure 5 and related

text) wherein application programs in the host processor send commands to task module

(col. 7, line 27-48)]

calculating a projected number of media for a future execution of at least one of the backup jobs

using the information regarding the future backup, and presenting the projected number of media

to a user [**Bolin discloses all cartridges are used for storage of data, and are intended to be written to or read in the future (figure 5 and related text) wherein step 260 in figure 6 is can be considered as presenting a projected number of one media to be loaded and used (figure 6 and related text); GUI for "alerting an operating to the need for mounting or demounting a particular data medium" (col. 5, lines 58-63; col. 7, lines 39-40)].**

Bolin does not explicitly disclose the details of "said calculating also comprising dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job".

Kanai discloses a plurality of backup jobs wherein "said calculating also comprising dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job" as [**"providing the estimation of future storage usage of the user by the rental storage service provider based on the history of storage usage of the user; and reporting the estimation to the storage user" (Page 1, Pars. 0018-0019; Pars. 0202, 0225 and 0234) wherein "the rental storage service provider 2 will estimate the future usage of storage data based on the history record of the usage data stored in the storage device(s) to report to the rental storage service user 1 the estimation" (Page 4; Par. 0091; Figure 2 and related text). See recommended capacity graph (Page 8, Par. 0176 and Figure 17)].**

Bolin et al. (US 5,664,146) and Kanai et al. (US 2002/0152181) are analogous art because they are from the same field of endeavor of computer memory access and control.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the storage management method/system as taught by Bolin and further provide

details of a plurality of backup jobs and said calculating comprising, for at least one of the future

executions, dividing an average historical backup size of the backup job by an average capacity

of a media type associated with the backup job as disclosed by Kanai.

The motivation for doing so would have been because Kani discloses **[that rented**

storage allows users to be released from the burden of maintenance of store and thereby

have less responsibility of administration (Par. 0005) wherein "the contract user will have

the amount of data more than the currently contracted capacity of 300GB... this display

screen may provide the user interface which is very easy to operate and easy to understand

for the rental storage service users" (Pages 8-9; Par. 0176)].

Therefore, it would have been obvious to combine Kanai et al. (US 2002/0152181) with

Bolin et al. (US 5,664,146) for the benefit of creating a method/system medium having stored

thereon sequences of instructions to obtain the invention as specified in claims 1, 17 and 23.

11.   As per **claim 3**, the combination of Bolin and Kanai discloses the method of claim 1,

wherein obtaining the information regarding the future backup further comprises obtaining

information for one or more backup devices, each backup device associated with at least one of

the backup jobs **[Bolin discloses all cartridges are used for storage of data wherein each**

device as shown in figure 5 corresponds to a storage job (figure 5 and related text; col. 7,

lines 1-26)].

12.   As per **claim 4**, the combination of Bolin and Kanai discloses the method of claim 3,

wherein presenting the projected number of media comprises presenting the projected number of

media required for each of the backup devices **[Bolin discloses wherein step 260 in figure 6 is**

can be considered as presenting a projected number of media to be loaded and used (figure

6 and related text); GUI for "alerting an operating to the need for mounting or demounting a particular data medium" (col. 5, lines 58-63; col. 7, lines 39-40)].

13.   As per **claim 5**, the combination of Bolin and Kanai discloses the method of claim 1, wherein obtaining the information regarding the future backup further comprises obtaining information for one or more media pools, each media pool associated with at least one of the backup jobs **[Bolin discloses migration and backup of data (col. 7, lines 5-8) wherein all cartridges are used for storage of data, and are intended to be written to or read in the future (figure 5 and related text) wherein application programs in the host processor send commands to task module (col. 7, line 27-48). The embodiment of figure 4 also covers individual media pools (col. 7, line 64-col. 8, line 3) and explains library dataserver displaying mount messages for a tape subsystem forming part of a plurality of tape subsystems (col. 9, lines 3-36; figures 4-5 and related text)]**.

14.   As per **claims 8, 18-19 and 24-25**, the combination of Bolin and Kanai discloses the method of claim 5, wherein presenting the projected number of media comprises presenting the projected number of media for each of the media pools **[Bolin discloses library dataserver displaying mount messages for a tape subsystem forming part of a plurality of tape subsystems (col. 9, lines 3-36; figures 4-5 and related text) wherein step 260 in figure 6 can be considered as presenting a projected number of media to be loaded and used (figure 6 and related text)]**.

15.   As per **claim 9**, the combination of Bolin and Kanai discloses the method of claim 5, wherein calculating further comprises using the media pool information to analyzing historical usage of the media pools as **[Kanai discloses "providing the estimation of future storage**

usage of the user by the rental storage service provider based on the history of storage

usage of the user; and reporting the estimation to the storage user" (Page 1, Pars. 0018-

0019; Pars. 0202, 0225 and 0234)].

16.   As per **claim 10**, the combination of Bolin and Kanai discloses the method of claim 5,

further comprising presenting a report to the user identifying at least one media pool having a

greater amount of media than the projected number of media for the at least one media pool

[Bolin discloses eject messages for media that is not required to be included in the

projected number of media for future storage jobs (figure 5 and related text)].

17.   As per claims **12-13**, the combination of Bolin and Kanai discloses The method of claim

1, further comprising: wherein obtaining the information regarding the future backup further

comprises obtaining information for one or more media pools, each media pool associated with

the backup jobs; and wherein calculating the projected number of media further comprises

totaling the number of media projected for each media pool to be used by the future execution;

wherein the obtaining the information regarding the future backup further comprises obtaining

information for one or more backup devices associated with the backup jobs; and wherein

calculating the projected number of media further comprises totaling the projected number of

media for each backup device to be used by the future execution **[Bolin discloses migration and**

backup of data (col. 7, lines 5-8) wherein all cartridges are used for storage of data, and are

intended to be written to or read in the future (figure 5 and related text) and step 260 in

figure 6 is can be considered as presenting a projected number of one media to be loaded

and used (figure 6 and related text); GUI for "alerting an operating to the need for

mounting or demounting a particular data medium" (col. 5, lines 58-63; col. 7, lines 39-40)

and explains having different tape pools (figure 4 and related text). Kanai discloses
"providing the estimation of future storage usage of the user by the rental storage service
provider based on the history of storage usage of the user; and reporting the estimation to
the storage user" (Page 1, Pars. 0018-0019; Pars. 0202, 0225 and 0234) wherein "the rental
storage service provider 2 will estimate the future usage of storage data based on the
history record of the usage data stored in the storage device(s) to report to the rental
storage service user 1 the estimation" (Page 4; Par. 0091; Figure 2 and related text). See
recommended capacity graph (Page 8, Par. 0176 and Figures 17 and 28) wherein the total
capacity of the storage system is shown and the total recommend capacity for certain time
periods is also shown].

18.   As per **claim 14**, the combination of Bolin and Kanai discloses the method of claim 1,
wherein calculating further comprises calculating the projected number of media for the future
execution of the backup jobs scheduled within a predetermined period of time [**Bolin discloses
all cartridges are used for storage of date wherein they are intended to be written to or
read in the future (figure 5 and related text) wherein step 260 in figure 6 can be considered
as presenting a projected number of media to be loaded and used within a predetermined
period of time (figure 6 and related text); note eject messages are sent to the user when
media is not longer necessary. Furthermore, Kanai discloses estimation of future storage
based on usage history of the user (Page 1, Pars. 0018-0019)**].

19.   As per **claims 15 and 21**, the combination of Bolin and Kanai discloses the method of
claim 1, further comprising receiving from the user a list of one or more media to be used [**Bolin
discloses cartridge (col. 9, line 51-col. 10, line 43; figure 5 and related text)**].

20.   As per **claims 16 and 22**, the combination of Bolin and Kanai discloses the method of

claim 15, further comprising for each media in the list, determining if the media is a valid media

[Bolin discloses "if the wrong volser has been mounted, the host issues a demount job and

then reissues a mount job, starting from step 236" (col. 11, line 52-54)].

21.   **Claims 6-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolin et al.

(US 5,664,146) in view of Kanai et al. (US 2002/0152181) as applied to claims 1 and 5 above,

and further in view of Carlson et al. (US 2004/0044862).

22.   As per **claim 6**, the combination of Bolin and Kanai discloses the method of claim 5, but

does not disclose expressly the details of calculating comprises, for each media pool:

determining an existing number of media in the media pool; calculating the projected number of

media for the future execution using the media pool; and subtracting the existing number from

the projected number.

        Carlson discloses of calculating comprises, for each media pool: determining an existing

number of media in the media pool; calculating the projected number of media for the future

execution using the media pool; and subtracting the existing number from the projected number

as [**"a system administrator may move physical volumes from one storage pool to another**

when managing the tape cartridges in the storage pools. This may be performed if a

determination is made that one storage pool needs additional tapes due to an anticipated

increase of data maintained in that pool, or one pool needs fewer tape cartridges due to an

anticipated decrease in data directed toward that pool" (Page 3, Par. 0044) and details

moving a number of physical volumes from a source pool to a target pool (figures 9-10 and

related text)].

Bolin et al. (US 5,664,146), Kanai et al. (US 2002/0152181) and Carlson et al. (US

2004/0044862) are analogous art because they are from the same field of endeavor of computer

memory access and control.

At the time of the invention it would have been obvious to a person of ordinary skill in

the art to modify the storage management method/system as taught by the combination of Bolin

and Kanai and further calculating a projected number of media by determining an existing

number of media in the media pool; calculating the projected number of media for the future

execution using the media pool; and subtracting the existing number from the projected number

as disclosed by Carlson.

The motivation for doing so would have been because Carlson discloses calculating a

projected number of media by determining an existing number of media in the media pool;

calculating the projected number of media for the future execution using the media pool; and

subtracting the existing number from the projected number is done to maintain the optimal

number of cartridges in a storage pool **[(par. 0044)]**.

Therefore, it would have been obvious to combine Kanai et al. (US 2002/0152181) with

Bolin et al. (US 5,664,146) and Carlson et al. (US 2004/0044862) for the benefit of creating a

method/system medium having stored thereon sequences of instructions to obtain the invention

as specified in claim 6.

23.   As per **claim 7**, the combination of Bolin, Kanai and Carlson discloses the method of

claim 6, wherein determining the existing number further comprises determining if a protected

period for one or more existing data media has expired **[Kanai discloses "the reporting process**

will also be executed if a predetermined period of time has expired" (Par. 0158) which

comprises a time period for the contract for data storage].

ACKNOWLEDGMENT OF ISSUES RAISED BY THE APPLICANT

Response to Amendment

24.   Applicant's arguments filed on January 18, 2008 with respect to Carlson have been

considered but they are moot in view of new grounds of rejection.

25.   Applicant's arguments filed on January 18, 2008 with respect to Kanai have been fully

considered but they are not persuasive.

26.   As required by **M.P.E.P. § 707.07(f)**, a response to these arguments appears below.

ARGUMENTS CONCERNING PRIOR ART REJECTIONS

27.   Claims must be given the broadest reasonable interpretation during examination and

limitations appearing in the specification but not recited in the claim are not read into the claim

(See M.P.E.P. 2111 [R-1]).

28.   Applicant argues that Bolin's does not "calculate a projected number of media" as

"assuming that all cartridges can be written fails to teach, suggest or even imply" this limitation.

        In response, these arguments have been fully considered, but are not deemed persuasive.

        In response to applicant's arguments against the references individually, one cannot show

nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*

Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Examiner would like to respectfully point out that the pending claims have been rejected under 35 USC 103 obviousness type rejection over Bolin in view of Kanai; wherein the combination of Bolin and Kanai discloses "calculate a projected number of media" as Bolin discloses [**all cartridges are used for storage of data, and are intended to be written to or read in the future (figure 5 and related text) wherein step 260 in figure 6 is can be considered as presenting a projected number of one media to be loaded and used (figure 6 and related text); GUI for "alerting an operating to the need for mounting or demounting a particular data medium" (col. 5, lines 58-63; col. 7, lines 39-40) wherein, the total of all cartridges in the system is deemed as the number of projected media; note that all the cartridges are calculated/deemed necessary for future data storage**] and Kanai further discloses [**"providing the estimation of future storage usage of the user by the rental storage service provider based on the history of storage usage of the user; and reporting the estimation to the storage user" (Page 1, Pars. 0018-0019; Pars. 0202, 0225 and 0234).** *Applicant should note that saving/storing data by a user within rental storage system comprises backup procedures from one or more backup applications; therefore, when estimating the number of future storage usage by a user; the rental storage service provider is calculating required number of media needed for one or more future executions of backup jobs*]. Thus, the combination of Bolin and Kanai teaches "calculate a projected number of media" as claimed.

29.   Applicant argues the combination of Bolin and Kanai does not disclose "obtaining information regarding a future backup from one or more backup applications for a plurality of

backup jobs; calculating a projected number of media for a future execution of at least one of the

backup jobs using the information regarding the future backup."

    In response, these arguments have been fully considered and are not deemed persuasive.

    The combination of Bolin and Kanai discloses "obtaining backup job information from

one or more backup applications for a plurality of backup jobs," as Bolin discloses [**Bolin**

discloses migration and backup of data (col. 7, lines 5-8) wherein all cartridges are used for

storage of data, and are intended to be written to or read in the future (figure 5 and related

text) wherein application programs in the host processor send commands to task module

(col. 7, line 27-48)] and Kanai discloses [**"providing the estimation of future storage usage of**

the user by the rental storage service provider based on the history of storage usage of the

user; and reporting the estimation to the storage user" (Page 1, Pars. 0018-0019; Pars.

0202, 0225 and 0234) wherein "the rental storage service provider 2 will estimate the future

usage of storage data based on the history record of the usage data stored in the storage

device(s) to report to the rental storage service user 1 the estimation" (Page 4; Par. 0091;

Figure 2 and related text). See recommended capacity graph (Page 8, Par. 0176 and Figure

17). *Applicant should note that saving/storing data by a user within rental storage system*

comprises backup procedures from one or more backup applications and that as it is estimated

the future storage usage of the user for the rental storage by the rental storage service

provider, the rental storage service provider considers either directly/indirectly "backup job

information from one or more backups applications for a plurality of backup jobs," as it

considers "history of usage"; and provides an estimate of storage that the user will need in

order to accommodate backup jobs by the user to the rental storage].

And "calculating a required number of scratch media needed for one or more future executions of the... backup jobs," as Bolin discloses **[all cartridges are used for storage of data, and are intended to be written to or read in the future (figure 5 and related text) wherein step 260 in figure 6 is can be considered as presenting a projected number of one media to be loaded and used (figure 6 and related text); GUI for "alerting an operating to the need for mounting or demounting a particular data medium" (col. 5, lines 58-63; col. 7, lines 39-40) wherein, the total of all cartridges in the system is deemed as the number of projected media; note that all the cartridges are calculated/deemed necessary for future data storage]** and Kanai clearly discloses "calculating a required number of scratch media needed for one or more future executions of the... backup jobs," as **["providing the estimation of future storage usage of the user by the rental storage service provider based on the history of storage usage of the user; and reporting the estimation to the storage user" (Page 1, Pars. 0018-0019; Pars. 0202, 0225 and 0234).** *Applicant should note that saving/storing data by a user within rental storage system comprises backup procedures from one or more backup applications; therefore, when estimating the number of future storage usage by a user; the rental storage service provider is calculating required number of media needed for one or more future executions of backup jobs*].

30.   Applicant remarks the combination of Bolin and Kanai does not disclose "receiving from the user a list of one or more media to be used" as "the lists of devices in Bolin's Figure 5 are not provided by the librarian or user, but are provided to the librarian as a list of things to do."

In response, these remarks have been fully considered and are not deemed persuasive.

The combination of Bolin and Kanai discloses "receiving from the user a list of one or more media to be used" as **[Bolin discloses cartridges where all cartridges are used for data storage (col. 9, line 51-col. 10, line 43; figure 5 and related text) wherein the mounting of at least one cartridge by the user according to action list is interpreted as a list of <u>one</u> <u>or</u> more media to be used]**.

31.   Applicant argues the combination of Bolin and Kanai does not disclose "a computer system configured to receive backup job information for a plurality of backup jobs from one or more backup applications, the backup job information includes an average historical backup size for one or more of the backup jobs;" however, this argument is not deemed persuasive as Kanai clearly discloses **["providing the estimation of future storage usage of the user by the rental storage service provider based on the history of storage usage of the user; and reporting the estimation to the storage user" (Page 1, Pars. 0018-0019; Pars. 0202, 0225 and 0234) wherein "the rental storage service provider 2 will estimate the future usage of storage data based on the history record of the usage data stored in the storage device(s) to report to the rental storage service user 1 the estimation" (Page 4; Par. 0091; Figure 2 and related text). See recommended capacity graph (Page 8, Par. 0176 and Figure 17).** *Applicant should note that saving/storing data by a user within rental storage system comprises backup procedures from one or more backup applications and that as it is estimated the future storage usage of the user for the rental storage by the rental storage service provider, the rental storage service provider considers either directly/indirectly "backup job information from one or more backups applications for a plurality of backup jobs," as it considers "history of usage"; and*

provides an estimate of storage that the user will need in order to accommodate backup jobs by

the user to the rental storage].

32.   The Examiner would also like to point out that the functional recitations of " configured

to [or capable of]" do not make the claimed invention patentably distinct over the prior art of

record. While features of a system may be recited either structurally or functionally, claims

directed to a system must be distinguished from the prior art in terms of structure rather than

function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431- 32 (Fed. Cir. 1997)

(The absence of a disclosure in a prior art reference relating to function did not defeat the Board's

finding of anticipation of claimed apparatus because the limitations at issue were found to be

inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ

226,228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528,531 (CCPA 1959).

"System claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch

& Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in

original). **[See MPEP 2106 II(C)]**.

        Still further, claims 17, and 21-22 recite, inter alias, "configured to [or capable of]."

While these limitation require structures such as computer system in claim 17, the functional

recitations following the terms "configured to" do not distinguish the claim from the prior art. .

33.   All arguments by the applicant are believed to be covered in the body of the office action;

thus, this action constitutes a complete response to the issues raised in the remarks dated July 31,

2008.

CLOSING COMMENTS

34.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Examiner's Note

35.   Examiner has cited particular columns and line numbers in the references as applied to

the claims above for the convenience of the applicant. Although the specified citations are

representative of the teachings in the art and are applied to the specific limitations within the

individual claim, other passages and figures may apply as well. It is respectfully requested from

the applicant, in preparing the responses, to fully consider the references in entirety as potentially

teaching all or part of the claimed invention, as well as the context of the passage as taught by

the prior art or disclosed by the examiner.

Conclusion

a. **STATUS OF CLAIMS IN THE APPLICATION**

36.   The following is a summary of the treatment and status of all claims in the application as recommended by **M.P.E.P. 707.07(i)**:

   a(1) CLAIMS REJECTED IN THE APPLICATION

37.   Per the instant office action, claims 1, 3-10, 12-19, and 21-25 received an action on the merits and are subject of a final rejection.

   a(2 CLAIMS NO LONGER UNDER CONSIDERATION

38.   Claims 2, 11, 20 and 26 stand canceled as of amendment date January 18, 2008.

   b. DIRECTION OF FUTURE CORRESPONDENCES

39.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaima Campos whose telephone number is (571) 272-1232. The examiner can normally be reached on Monday to Friday 8:30 AM to 5:00 PM.

IMPORTANT NOTE

40.   If attempts to reach the above noted Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Sanjiv Shah, can be reached at the following telephone number: Area Code (571) 272-4098.

   The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more

information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions

on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-

9197 (toll-free).

November 4, 2008   /Yaima Campos/
                                                   Examiner, Art Unit 2185

/Sanjiv Shah/

Supervisory Patent Examiner, Art Unit 2185